UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,199	04/19/2004	David Lee Daniels	BIG0001-00	2330

48394 7590 11/19/2008		

DIEHL SERVILLA LLC
77 BRANT AVE
SUITE 210
CLARK, NJ 07066

EXAMINER
SALL, EL HADJI MALICK

ART UNIT	PAPER NUMBER
2457	

NOTIFICATION DATE	DELIVERY MODE
11/19/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@dsiplaw.com
skahaly@dsiplaw.com
jescobar@dsiplaw.com

	Application No.	Applicant(s)
Office Action Summary	10/827,199	DANIELS ET AL.
	Examiner	Art Unit	
	EL HADJI M. SALL	2457	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _29 July 2008_.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-21_ is/are pending in the application.
    4a) Of the above claim(s) _10-21_ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1-9_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
    1.☐ Certified copies of the priority documents have been received.
    2.☐ Certified copies of the priority documents have been received in Application No. _____.
    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the amendment filed on July 29, 2008. Claims 1-21

are pending. Claims 10-21 are withdrawn from consideration. Claims 1-21 represent

universal recallable, erasable, secure and timed delivery email.

2.   *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or

described as set forth in section 102 of this title, if the differences between the

subject matter sought to be patented and the prior art are such that the subject

matter as a whole would have been obvious at the time the invention was made to a

person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Thorne et al. U.S. 5,958,005 in view of Higley U.S. 6,065,048.

Thorne teaches the invention substantially as claimed including electronic mail

security (abstract).

As to claims 1 and 8, Thorne teaches a process, a method and a system for

secure and timed delivery of recallable and erasable email comprising:

a sender preselecting with sender's hypertext transport protocol server the

sender's preferences for the number of times his emails will be displayable and for the

length of time his emails will remain active and available for viewing (column 7, line 66

to column 8, line 12),

a sender's mail user agent creating and sending an email to a sender's modified

mail transport agent, said sender's modified mail transport agent preprocessing said

email by taking the body from the email and creating and storing an image of the body

on a file system and then creating a link to the image that is inserted back into the

email as a replacement for the body of the email to form a modified email (column 3,

lines 12-23),

sender's modified mail transport agent creates an entry for the email in a data

base containing the body of the email and time saved along with the sender's

preselected preferences and a blank field for recording the time the email is first

displayed (column 3, lines 36-46),

sender's modified mail transport agent sending the modified email to a recipient's

mail transport agent where the modified email is stored awaiting recipient's

request, recipient's mail user agent requesting and receiving said modified

email from recipient's mail transport agent (column 9, lines 54-67),

the data base recording the time the email is first displayed and counting down

on the counter for the total number of times the email is displayable (column 3, lines

36-46; column 7, line 66 to column 8, line 12),

the image displayed for the recipient (figure 5B, item 546).

Thorne fails to teach explicitly mail user agent, mail transport agent or hypertext

transport protocol server.

However, Higley teaches method and system to create, transmit, receive and

process information, including an address to further information. Higley teaches mail

user agent, mail transport agent or hypertext transport protocol server (figure 2, items

206, 208; column 3, lines 19-30).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine Thorne in view of Higley to provide mail user agent,

mail transport agent or hypertext transport protocol server, recipient executing the link

contained in the modified email to request the image of the body of the email

from sender's hypertext transport protocol server, and sender's hypertext transport

protocol server obtaining the image and sending the image to the recipient. One would

be motivated to do so to allow connecting to servers in the web and to provide sending

and receiving documents in email over the internet (see abstract).

As to claim 2, Thorne and Higley teach a process for secure and timed delivery

of recallable and erasable email according to claim 1 wherein sender's mail user agent

employs a secure transmission in sending the email to the sender's modified mail

transport agent, and sender's hypertext transport protocol server employs a secure

transmission in sending the image to the recipient (column 12, lines 3-16).

As to claim 3, Thorne and Higley teach a process for secure and timed delivery

of recallable and erasable email according to claim 2 wherein the step of said sender's

modified mail transport agent preprocessing said email to create a modified email that

has had a link to a stored image of the body from the email substituted for the body of

the email further comprises:

sender's modified mail transport agent strips the body from the email and creates

an image file of the body and stores the image file on a file system, sender's modified

mail transport agent creates an entry for the email in a data base, and sender's

modified mail transport agent creates a link to the stored image and substitutes the link

in the email for the body of the email thereby creating a modified email (column 3, lines

12-23).

As to claim 4, Thorne and Higley teach a process for secure and timed delivery

of recallable and erasable email according to claim 3 wherein the entry created in a

data base by the sender's modified mail transport agent for the email further

comprises: the body of the email, the time the email was saved, a field for recording

the time the email is first displayed, a counter that is set for the total number of times

the email is displayable, and the removal time (column 7, line 66 to column 8, line 12).

As to claim 5, Thorne and Higley teach a process for secure and timed delivery of recallable and erasable email according to claim 4 further comprising the following steps which occur after the step of executing the link contained in the modified email to request the image of the body of the email from sender's hypertext transport protocol server:

sender's hypertext transport protocol server receives the request for the image from the recipient, and the data base records the time the email is first displayed and counts down one numeral on the counter for the total number of times the email image is displayable (column 7, line 66 to column 8, line 12; column 3, lines 59-67).

As to claims 6, 7 and 9, Thorne and Higley teach a process for secure and timed delivery of recallable and erasable email according to claims 5 and 8 further comprising the following steps which can occur at any time:

sender logs onto the website for sender's hypertext transport protocol server, sender views all active emails that he has sent and the status of each, sender edits his active emails and edits his preferences, the sender's hypertext transport protocol server overwrites the original image files and original content of the email and changes sender's preferences, and sender logs off of the website (column 7, line 66 to column 8, line 12).

4.   *Response to Arguments*

Applicant's arguments filed 07/29/08 have been fully considered but they are not persuasive.

(A)   Applicants argue that Thorne is silent in that section or anywhere else about a stored image of the body of the e-mail, and about substituting the body of the email by a link to that image.

In regards to point (A), examiner respectfully disagrees.

In column 2, lines 51-54, Thorne discloses a recipient to copy and store the email document. The copy of the message is the image of the message, and such copy is a substitute of the document (i.e. substituting the body of the email by a link to that copy or image).

In column 9, lines 44-53, Thorne discloses email message retrieval procedure, and scanning email messages to locate secure messages in the client computer. Such messages are purges, and notification of such purge is sent to the user.

In column 3, lines 18-21, Thorne discloses a mail exchange agent acting as a store which forward node in transport of the message within the same department or another department.

(B)   Applicants argue that Higley does not teach "...preprocessing said email to create a modified email that has a link to a stored image of the body from the email substituted for the body of the email..." Higley is silent about using a URL for substituting it with the body of an email.

In regards to point (B), examiner respectfully disagrees.

In column 2, lines 51-54, Thorne discloses a recipient to copy and store the email document. The copy of the message is the image of the message, and such copy is a substitute of the document (i.e. substituting the body of the email by a link to that copy or image). Furthermore, Higley was not use to substitute his URL with the body of an email.

(C)   Applicants argue that Higley does not provide any suggestion or motivation to replace a body of an email with a URL to an image of the body of the email. Accordingly, neither Thorne, nor Higley, nor the combination thereof, teaches or suggests amended claim 1 and claim 8.

In regards to point (C), examiner respectfully disagrees.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re*

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one would be

motivated to do so to allow connecting to servers in the web and to provide sending and

receiving documents in email over the internet (see abstract).

5.   *Conclusion*

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Examiner has cited particular columns and line numbers in the references

applied to the claims above for the convenience of the applicant. Although the specified

citations are representative of the teachings of the art and are applied to specific

limitations within the individual claim, other passages and figures may apply as well. It

is respectfully requested from the applicant in preparing responses, to fully consider the

references in entirety as potentially teaching all or part of the claimed invention, as well

as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully

requested to indicate the portion(s) of the specification which dictate(s) the structure

relied on for proper interpretation and also to verify and ascertain the metes and bounds

of the claimed invention.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to El Hadji M Sall whose telephone number is 571-272-

4010. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

/El Hadji M Sall/

Examiner, Art Unit 2457

/LaShonda T Jacobs/

Primary Examiner, Art Unit 2457